

## **REMARKS**

Applicant respectfully requests reconsideration of this application as amended. Claims 1, 11 and 16 have been amended. Claims 25-27 were previously cancelled without prejudice. No new claims have been added. Therefore, claims 1-24 are presented for examination. The following remarks are in response to the final Office Action, mailed July 18, 2008.

### **35 U.S.C. § 112 Rejection**

Claims 1-24 are rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 11 and 16 have been amended. Applicants respectfully request the withdrawal of the rejection of claims 1, 11 and 16 and their dependent claims.

### **35 U.S.C. § 103 Rejection**

Claims 1-3, 8, 16-18 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”).

Claim 1, as amended, recites:

A method of controlling transfer of health information along a network pathway, the method comprising:

receiving, by an access server on the network pathway, a request for the health information from across an internal network, the request being generated from a portable healthcare device on the network pathway;

immediately determining, by the access server, if a corresponding consent is stored in the access server and whether the consent satisfies requirements for release of the health information, wherein the consent is for a requestor of the health information to access the health information and the consent is provided by an owner of the health information, wherein the consent is based on results provided by a filtering component, the filtering component to filter the health information based on the request such that an

unnecessary portion of the health information is filtered out, wherein the request includes an intended use of the health information, wherein the intended use of the health information of the request is used to determine appropriateness of the consent or requirements for the consent, wherein a purpose field is provided to specify intended reasons for which the health information is accessed according to the consent; and

if the corresponding consent is stored, permitting, by the access server, the health information to be immediately acquired by sending the request across an external network to a remote site, receiving the health information from the remote site, and forwarding the health information back across the internal network.

Schoenberg discloses a “method of and system for distributing medical information for an individual over a communications network is disclosed. The method includes the steps of generating a plurality of security access codes, generating a plurality of hierarchical categories, ranging from a low security category to a high security category, categorizing the individual's medical information into privacy levels ranging from a least private level to a most private level, inputting the individual's categorized medical information into the plurality of hierarchical categories, the least private level being input into the low security category and the most private level being input into the high security category and assigning, to each of the categories, one or more of the access security codes, such that the medical information in each category will be released only if the assigned access security codes are received.” (Abstract; emphasis added).

The Examiner acknowledges that Schoenberg does not teach or reasonably suggest “the request includes an intended use of the health information, wherein the intended use of the health information of the request is used to determine appropriateness of the consent or requirements for the consent, wherein a purpose field is provided to specify intended reasons for which the health information is accessed according to the consent” as recited by claim 1 (emphasis added). However, the Examiner relies on

Rozen to make up for the deficiencies of Schoenberg. (page 7, Office Action, mailed 07-18-08). Applicants respectfully disagree with the Examiner's characterization of the references and the pending claims.

For example, the Examiner relies upon to assert that Rozen's Fig 1A, column 2, discloses “***the appropriate set of medical record is provided***” (page 7, Office Action, mailed 07-18-08; emphasis provided). Having an ***appropriate set of medical records*** has **nothing to do with** and is **not the same** as the intended use of the health information of the request is used to determine appropriateness of the consent or requirements for the consent as recited by claim 1. For example, the appropriateness of the consent deals with the appropriateness of the consent itself, which is **not the same** as ***providing appropriate medical records***. (see claim 1; see also paragraph 0048 of the Specification). Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 1 and its dependent claims.

Furthermore, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d

1385, 1396 (2007).

Schoenberg and Rozen, neither individually nor when combined, teach or reasonably suggest all the features of claim 1 and a *prima facie* case of obviousness has not been met under MPEP §2142. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 1 and its dependent claims.

Claims 11 and 16 contain limitations similar to those of claim 1. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 11 and 16 and their dependent claims.

Claims 4-5 and 19-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) as applied to parent claims 3 and 18 above and further in view of Edelson, U.S. Patent No. 5,737,539 (“Edelson”).

Claims 4-5 and 19-20 depend from one of claims 1 and 16. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 4-5 and 19-20.

Claims 6 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) as applied to parent claims 1 and 16 above, and further in view Snowden, U.S. Patent Application No. 2002/0026332 (“Snowden”) and Edelson, U.S. Patent No. 5,737,539 (“Edelson”).

Claims 6 and 21 depend from one of claims 1 and 16. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 6 and 21.

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) as applied to parent claim 1 above, and further in view Applicant Admitted Prior Art (“AAPA”).

Claim 7 depends from claim 1. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 7.

Claims 9-13 and 23-24 are rejected under 35 U.S.C. § 103(a) as being obvious over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) as applied to claims 1 and 16 above as applicable, and further in view of Applicant Admitted Prior Art (“AAPA”).

Applicants respectfully disagree with the Examiner’s Official Notice and request the Examiner provide additional evidence and details to justify the Official Notice.

Claims 9-10, 12-13 and 23-24 depend from one of claims 1, 11 and 16. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 9-10, 12-13 and 23-24.

Regarding claim 11, Applicants request the Examiner explain the rejection of each and every element of claim 11. Furthermore, claim 1 contains limitations similar to those of claim 1 and 16. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 11.

Claims 14-15 are rejected under 35 U.S.C. § 103(a) as being obvious over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) and Applicant Admitted Prior Art (“AAPA”) as applied to

claims 11 above, and further in view of de la Huerga, U.S. Patent No. 5,903,889 (“de la Huerga”).

Claims 14-15 depend from claim 11. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 14-15.

### **Conclusion**

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

### **Invitation for a Telephone Interview**

The Examiner is requested to call the undersigned at (303) 740-1980 if there remains any issue with allowance of the case.

### **Request for an Extension of Time**

Applicant respectfully petitions for a one month extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a). Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17(a) for such an extension.

### **Charge our Deposit Account**

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: November 5, 2008

/Aslam A. Jaffery/

Aslam A. Jaffery

Reg. No. 51,841

12400 Wilshire Boulevard  
7<sup>th</sup> Floor  
Los Angeles, California 90025-1030  
(303) 740-1980